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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/706,170	MARUKAWA, KAZUYUKI
Examiner	Art Unit	
Doug Hutton	2179	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 February 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-99 is/are pending in the application.
 4a) Of the above claim(s) 41-83 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 18-40 and 84-99 is/are rejected.
 7) Claim(s) 1-17 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 03 November 2000 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Applicant's Response

In Applicant's Response dated 22 February 2005, Applicant amended Claims 1-3, 13, 18, 19, 26, 27 and 39, and argued against all objections and rejections previously set forth in the Office Action dated 21 December 2004.

All claim objections previously set forth are withdrawn. All rejections previously set forth under 35 U.S.C. 112, second paragraph, are withdrawn. All rejections for Claims 1-17 are withdrawn.

Claim Objections

Claims 1-~~12~~¹¹ are objected to because of the following informalities:

- the phrase "an electronic document" in Claim 1, Line 4 should be amended to — electronic documents, wherein each electronic document is categorized — because the "categorizing means" is used to categorize multiple documents and generate a categorization model;
- the term "each" should be inserted between the terms "said" and "electronic" in Claim 1, Line 5 so that the phrase corresponds to the above suggested amendment to the claim;
- the phrase "the electronic document" in Claim 1, Line 7 should be amended to — one of the electronic documents — so that the phrase corresponds to the above suggested amendment to the claim;

Art Unit: 2179

- the phrase “a category” in Claim 1, Line 11 should be amended to — the category — because the “specified category” is previously mentioned in Claim 1 (see Line 8); and
- the phrase “the desired electronic document” in Claim 1, Line 15 should be amended to — a desired electronic document — because this document is not one of the documents previously recited in Claim 1, Line 4.

Claim 13-17 are objected to because of the following informalities:

- the phrase “an electronic document into one of categories” in Claim 13, Line 2 should be amended to — electronic documents, wherein each electronic document is categorized into one of a plurality of categories — because the “categorizing means” is used to categorize multiple documents and generate a categorization model and because there are a plurality of categories;
- the term “each” should be inserted between the terms “said” and “electronic” in Claim 13, Line 3 so that the phrase corresponds to the above suggested amendment to the claim;
- the phrase “the electronic document” in Claim 13, Line 5 should be amended to — one of the electronic documents — so that the phrase corresponds to the above suggested amendment to the claim; and
- the phrase “a category” in Claim 13, Line 9 should be amended to — the category — because the “specified category” is previously mentioned in the claim (see Line 6).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-22, 24-35, 37-40 and 84-99 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferguson et al., U.S. Patent No. 5,819,092.

Claim 18:

Ferguson discloses a document providing device (see Figure 1; see Column 8, Lines 4-28 – Ferguson discloses this limitation in that the online development tool is used to create online computer services that involve clients and servers), comprising:

- a database for storing a plurality of electronic documents (see Column 13, Line 65 through Column 14, Line 12 – Ferguson discloses this limitation in that the online services provide searchable directories of information comprising hyperdocuments. Thus, Ferguson discloses a “database for storing a plurality of electronic documents.”);
- retrieval means for retrieving a desired electronic document from the electronic documents stored in said database (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories.);

- communication means for communicating with said terminal device (see Figure 1
 - Ferguson discloses this limitation in that the online services connect the clients and servers via a communications network.); and
- control means for controlling said communication means and said retrieval means such that when said communication means receives said characteristic information, said retrieval means retrieves the electronic document related to said characteristic information from the electronic documents stored in said database, and said communication means transmits information associated with the retrieved electronic document to said terminal device (see Figure 1; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to retrieve hyperdocuments from the directory and receive the retrieved hyperdocuments at their computers.).

Claim 19:

Ferguson discloses the document providing device according to Claim 18, wherein said control means transmits the electronic document itself extracted by retrieval, as said information associated with the retrieved electronic document, to said terminal device via said communication means (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 →

Ferguson discloses the above limitation in that the online services development tool is used to design and construct online computer services that include searching, downloading and viewing online information. The tool is used to create the data structures, documents, scripts and HTTP software to implement the online services. Features provided by such online services include: displaying hypermedia and portable documents, full-text indexing, full-text searching, full-text retrieving, attribute-based searching, downloading data or programs and controlling access to online information.

In the areas of indexing, searching and retrieving online documents, the online services comprise a "directory lookup subservice," a "document retrieval subservice," an "electronic publishing subservice" and a "document harvester." Each of these subservices are further described in the following discussion.

The "directory lookup subservice" provides a searchable directory of information that includes hyperdocuments that can be arranged into categories. The hyperdocuments in this directory are searchable by name, by category or by keywords.

The "document retrieval subservice" allows users to retrieve documents using full-text search techniques with user-specified categories and keywords. This subservice provides searchable access to a large corpus of text and makes files on a file server available to geographically remote users.

The "electronic publishing subservice" provides users with an electronic edition of a newspaper or magazine that the user can download to the client computer. This subservice creates a customized daily newspaper that provides only news stories that match certain criteria provided previously by the user.

The "document harvester subservice" allows users to specify files, directories and volumes that should be indexed for full-text search and retrieval. The file/directory/volume entities are displayed in a graphical tree structure so that the user can easily specify particular entities for indexing.

Each of the above elements are expressly disclosed in Ferguson. However, a reference's disclosure may also be implied. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998).

Ferguson would have implied to one having ordinary skill the art the following:

Using the online services development tool, a developer could have created a search tool that retrieved electronic documents from a server based on search criteria submitted by a client user and presented a list of every retrieved document to the user at the client. Upon receipt of the list, the user would have selected the documents that he/she desired to view. Upon selection, the server delivered the selected document to the client computer.

Ferguson would have implied the aforementioned disclosure because that is how typical search and retrieval systems worked at the time the invention was made.

Thus, the online services in Ferguson disclose a "control means" of said document providing device that "transmits an electronic document itself extracted by retrieval.").

Claim 20:

Ferguson discloses the document providing device according to Claim 18, wherein said control means transmits a list of electronic documents extracted by retrieval, as said information associated with the retrieved electronic document, to said terminal device via said communication means (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – As discussed in the above rejection for Claim 19, Ferguson discloses the features of a typical search and retrieval system, which include the server presenting a list of every retrieved document to the user at the client. Thus, the online services in Ferguson disclose a “control means” of said document providing device that “transmits a list of electronic documents extracted by retrieval”).

Claim 21:

Ferguson discloses the document providing device according to Claim 20, wherein when electronic document specifying information which specifies a particular electronic document of the electronic documents included in said list is received from said terminal device, said control means transmits the electronic document specified by said electronic document specifying information to said terminal device via said communication means (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see

Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – As discussed in the above rejection for Claim 19, Ferguson discloses the features of a typical search and retrieval system, which include the user selecting the documents that he/she desired to view. Thus, the online services in Ferguson disclose a client computer that further comprises: 1) receiving at the server an “electronic document specifying information which specifies a particular electronic document of the electronic documents included in said list;” and 2) a “control means” that “transmits the electronic document specified by said electronic document specifying information to said terminal device via said communication means.”).

Claim 22:

Ferguson discloses the document providing device according to Claim 20, wherein said control means produces said list such that electronic documents retrieved by said retrieval means from said database are all included in said list, and said control means transmits said list to said terminal device via said communication means (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – As discussed in the above rejection for Claim 19, Ferguson discloses the features of a typical search and retrieval system, which include the server putting together a list that includes every retrieved document and transmitting the list to the

user at the client. Thus, the online services in Ferguson disclose a “control means” of the server that “produced said list such that electronic documents retrieved by said retrieval means from said database are all included in said list.”).

Claim 24:

Ferguson discloses the document providing device according to Claim 20, wherein said control means produces said list such that a full or partial set of electronic documents retrieved by said retrieval means from said database is sorted and the resultant sorted set of electronic documents is included in said list, and said control means transmits said list to said terminal device via said communication means (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – As discussed in the above rejection for Claim 19, Ferguson discloses the features of a typical search and retrieval system, which include the server putting together a list that includes every retrieved document and transmitting the list to the user at the client. Also, the list is *inherently* “sorted” in that any list of retrieved documents will be in some sort of order. Thus, the online services in Ferguson disclose a “control means” of the server that “produced said list such that a full or partial set of electronic documents retrieved by said retrieval means from said database is sorted and the resultant sorted set of electronic documents is included in said list.”).

Claim 25:

Ferguson discloses the document providing device according to Claim 18, further comprising accounting means for, when said document providing device transmits the electronic document to said terminal device, performing an accounting process associated with the fee to said terminal device (see Column 25, Lines 41-46; see Column 29, Line 35 through Column 31, Line 58 – Ferguson discloses this limitation in that the online development tool includes a “fee setter subtool” that allows a developer to specify the fees that will be levied on users that download documents from the servers or paid to content providers that provide content to the servers.).

Claim 26:

Ferguson discloses a document processing method (see Figure 1; see Column 8, Lines 4-28 – Ferguson discloses this limitation in that the online development tool is used to create online computer services that involve clients and servers), comprising the steps of:

- categorizing electronic documents into a plurality of categories in accordance with the characteristic of the respective electronic documents (see Column 13, Line 65 through Column 14, Line 12; see Column 18, Lines 13-22 – Ferguson discloses this limitation in that the online services created by the development tool provide searchable directories of hyperdocuments arranged in categories and allows client users to search the directory by categories. Also, Ferguson discloses this limitation in that the online services include a “document harvester”

that allows a user to index documents uploaded to or downloaded from the system. Thus, the online services "categorize electronic documents into a plurality of categories in accordance with the characteristic of the respective electronic documents.");

- requesting specifying an electronic document categorized in one of said categories or specifying of one of said categories (see Column 13, Line 65 through Column 14, Line 12 – Ferguson discloses this limitation in that the online services allow client users to search the documents in storage directories by names, categories or keywords.); and
- transmitting, to a document providing device, the electronic document or characteristic information indicating the characteristic of a category, specified in response to said request in said requesting step (see Column 13, Line 65 through Column 14, Line 12; see Column 18, Lines 13-22; see Column 31, Lines 32-42 – Ferguson discloses this limitation in that the online services transmit a client user's search requests to the servers via the communications network.).

Claim 27:

Ferguson discloses the document processing method of Claim 26, wherein in said transmission step, the specified electronic document or characteristic information indicating the characteristic of a specified category is transmitted together with an identifier of the specified electronic document or category to said document providing device (see Column 13, Line 65 through Column 14, Line 12; see Column 18, Lines 13-

22 – Ferguson discloses this limitation in that the online services provide a “directory lookup subservice” that allows the user to specify a particular category of documents in which to conduct the search.).

Claim 28:

Ferguson discloses the document processing method of Claim 26, further comprising the steps of:

- requesting, when a list of electronic documents retrieved in accordance with said characteristic information is received from said document providing device, inputting of electronic document specifying information which specifies a particular electronic document of those included in said list; and
- transmitting, to said document providing device, the electronic document specifying information input in response to said request (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – As discussed in the above rejection for Claim 19, Ferguson discloses the features of a typical search and retrieval system, which include the user selecting the documents that he/she desired to view. Thus, the online services in Ferguson disclose a client computer that further comprises “inputting electronic document specifying information to specify a

particular electronic document of those included in said list" and transmitting said user specification to the server).

Claim 29:

Ferguson discloses the document processing method of Claim 26, wherein in said categorizing step, a category, in which the electronic document received from said document providing device is to be categorized, is temporarily determined in accordance with the characteristic of said electronic document, if said temporarily-determined category is the same as the category specified in response to said specifying request or as the category to which the specified electronic document belongs, said electronic document received from said document providing device is categorized into said category, and if said temporarily-determined category is different from the category specified in response to said specifying request or from the category to which the specified electronic document belongs, said electronic document received from said document providing device is categorized into a category in accordance with an instruction given by a user (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – As discussed in the above rejection for Claim 19, Ferguson discloses the features of a typical search and retrieval system, which include the server comparing whether the searched documents meet the categorization criteria specified by the user. That is, if the category is the same, then

the document is transmitted to the client computer provided the document meets all other search criteria specified by the user, and, if the category is different, then the document fails to meet the search criteria specified by the user and is not transmitted to the client computer.).

Claim 30:

Ferguson discloses the document processing method of Claim 29, wherein in said categorizing step, when the electronic document received from said document providing device is categorized into a category, category information is updated (see Column 18, Lines 13-22 – Ferguson discloses this limitation in that the online services include a “document harvester” that allows a user to index documents uploaded to or downloaded from the system. Thus, the “categorizing means categories the electronic document received from said document providing device into a category” and “updates the category information.”).

Claim 31:

Ferguson discloses a document processing method (see Figure 1; see Column 8, Lines 4-28 – Ferguson discloses this limitation in that the online development tool is used to create online computer services that involve clients and servers.), comprising the steps of:

- when characteristic information of an electronic document or a category is received, retrieving an electronic document related to said characteristic

information from a plurality of electronic documents stored in a database (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 31, Lines 32-42 – Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories by transmitting a client user's search requests to the servers via the communications network.); and

- transmitting information associated with the electronic document retrieved in said retrieving step (see Figure 1; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to retrieve hyperdocuments from the directory and receive the retrieved hyperdocuments at their computers.).

Claim 32:

Ferguson discloses the document processing method of Claim 31, wherein in said transmission step, the electronic document itself extracted by retrieval is transmitted, as said information associated with the retrieved electronic document, to said terminal device (As indicated in the above rejection for Claim 19, Ferguson discloses "transmitting the retrieved electronic documents and information associated with the documents to the terminal device.").

Claim 33:

Ferguson discloses the document processing method of Claim 31, wherein in said transmission step, a list of electronic documents extracted by retrieval is transmitted, as said information associated with the retrieved electronic document, to said terminal device (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – As discussed in the above rejection for Claim 19, Ferguson discloses the features of a typical search and retrieval system, which include the server presenting a list of every retrieved document to the user at the client. Thus, the online services in Ferguson disclose a “control means” of said document providing device that “transmits a list of electronic documents extracted by retrieval.”).

Claim 34:

Ferguson discloses the document processing method of Claim 33, wherein in said transmission step, when electronic document specifying information which specifies a particular electronic document of the electronic documents included in said list is received from said terminal device, the electronic document specified by said electronic document specifying information is transmitted to said terminal device (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through

Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – As discussed in the above rejection for Claim 19, Ferguson discloses the features of a typical search and retrieval system, which include the user selecting the documents that he/she desired to view. Thus, the online services in Ferguson disclose a client computer that further comprises “electronic document specifying means” for “inputting electronic document specifying information to specify a particular electronic document of those included in said list” and transmitting said user specification to the server.).

Claim 35:

Ferguson discloses the document processing method of Claim 33, wherein in said transmission step, said list is produced such that electronic documents retrieved from said database in said retrieving step are all included in said list, and said list is transmitted to said terminal device (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – As discussed in the above rejection for Claim 19, Ferguson discloses the features of a typical search and retrieval system, which include the server putting together a list that includes every retrieved document and transmitting the list to the user at the client. Thus, the online services in Ferguson disclose a “control means” of the server that “produced said list

such that electronic documents retrieved by said retrieval means from said database are all included in said list.").

Claim 37:

Ferguson discloses the document processing method of Claim 33, wherein in said transmission step, said list is produced such that a full or partial set of electronic documents retrieved from said database in said retrieving step is sorted and the resultant sorted set of electronic documents is included in said list, and said list is transmitted to said terminal device (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – As discussed in the above rejection for Claim 19, Ferguson discloses the features of a typical search and retrieval system, which include the server putting together a list that includes every retrieved document and transmitting the list to the user at the client. Also, the list is ***inherently*** “sorted” in that any list of retrieved documents will be in some sort of order. Thus, the online services in Ferguson disclose “producing the list such that a full or partial set of electronic documents retrieved from said database in said retrieving step is sorted and the resultant sorted set of electronic documents is included in said list.”).

Claim 38:

Ferguson discloses the document processing method of Claim 31, further comprising an accounting step for, when the electronic document is transmitted to said terminal device, performing an accounting process associated with the fee to said terminal device (see Column 25, Lines 41-46; see Column 29, Line 35 through Column 31, Line 58 – Ferguson discloses this limitation in that the online development tool includes a “fee setter subtool” that allows a developer to specify the fees that will be levied on users that download documents from the servers or paid to content providers that provide content to the servers.).

Claims 39 and 40:

Claims 39 and 40 merely recite computer software that performs the methods of Claims 26 and 31, respectively. Thus, Ferguson discloses every limitation of Claims 39 and 40, as indicated in the above rejections for Claims 26 and 31.

Claim 84:

Ferguson discloses a document processing method (see Figure 1; see Column 8, Lines 4-28 – Ferguson discloses this limitation in that the online development tool is used to create online computer services that involve clients and servers.), comprising the steps of:

- setting specification information to specify an electronic document (see Column 13, Line 65 through Column 14, Line 12 – Ferguson discloses this limitation in

- that the online services allow client users to search the documents in storage directories by names, categories or keywords.);
- transmitting, to a service providing device, specification information set in said specification information setting step and request information indicating a request for a tagged electronic document including a tag indicating the structure of the electronic document specified by said request information (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 18, Lines 13-22; see Column 31, Lines 32-42 – Ferguson discloses this limitation in that the online services transmit a client user's search requests to the servers via the communications network, wherein the client user's search requests may specify both categories and keywords of the sought documents. Also, Ferguson discloses this limitation in that the online services allows a user to search hyperdocuments, which include HTML documents having "tags" that "indicate the structure of the electronic document specified by the request information.");
 - receiving the tagged electronic document which is transmitted from said service providing device in response to said request information and said specification information (see Figure 1; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to retrieve hyperdocuments from the directories and receive the retrieved hyperdocuments at their computers.).

Claim 85:

Ferguson discloses the method of Claim 84, wherein in said specification information setting step, said specification information is set using an identifier of an electronic document (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow the user to retrieve text files, which may be retrieved by specifying the name of the text file.).

Claim 86:

Ferguson discloses the method of Claim 84, wherein in said specification information setting step, said specification information is set using a keyword included in an electronic document (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow the user to retrieve hyperdocuments via keywords.).

Claim 87:

Ferguson discloses the method of Claim 84, wherein in said transmission step, an electronic document is transmitted together with said request information to said service providing device (see Column 13, Line 65 through Column 14, Line 12; see Column 18, Lines 13-22; see Column 31, Lines 32-42 – Ferguson discloses this limitation in that the online services transmit a client user's search requests to the servers via the communications network. Also, Ferguson discloses this limitation in that

the online services include a “document harvester” that allows a user to index documents uploaded to or downloaded from the system. Also, Ferguson discloses this limitation in that the online services provide a means for paying a content provider for documents that are uploaded to the system via the communications network and then accessed by users on the system. In order to properly categorize such documents, the content providers will use Directory Lookup services to categorize and provide “request information” for the uploaded documents.).

Claim 88:

Ferguson discloses the method of Claim 87, wherein in said specification information setting step, said specification information is set using an identifier indicating an electronic document to be transmitted to said service providing device (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 18, Lines 13-22; see Column 31, Lines 32-42 – Ferguson discloses this limitation in that the online services allow the user to upload hyperdocuments to the system. In doing this, the user must *inherently* “specify the identify” of the document being uploaded in that no document will be uploaded unless it is “identified” to the system.).

Claim 89:

Ferguson discloses a document processing method (see Figure 1; see Column 8, Lines 4-28 – Ferguson discloses this limitation in that the online development tool is

used to create online computer services that involve clients and servers.), comprising the steps of:

- receiving, from a terminal device, specification information specifying an electronic document and request information indicating a request for a tagged electronic document including a tag indicating the structure of the electronic document specified by said request information (see Figure 1; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow the directories to receive search requests sent by client users to retrieve hyperdocuments from the directory and receive the retrieved hyperdocuments at their computers. Also, Ferguson discloses this limitation in that the online services allows a user to search directories of hyperdocuments that include HTML documents having “tags” that “indicate the structure of the electronic document specified by the request information.”);
- determining whether a database includes said tagged electronic document of the electronic document specified by said specification information received in said receiving step (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories.); and
- when it is determined in said determining step that said database includes said tagged electronic document of the electronic document specified by said

specification information, reading said tagged electronic document from said database and transmitting it to said terminal device (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories.).

Claim 90:

Ferguson discloses the method of Claim 89, further comprising the steps of:

- when it is determined in said determining step that said database includes the electronic document specified by said specification information, requesting an authoring device to produce a tagged electronic document of said electronic document (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories. The “authoring device” is that part of the system that retrieves the search results from the directories.); and
- when said tagged electronic document is received from said authoring unit, transmitting said tagged electronic document to said terminal device (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories.).

Claim 91:

Ferguson discloses the method of Claim 89, further comprising the step of, when it is determined in said determining step that said database includes neither the electronic document specified by said specification information nor the tagged electronic document of said electronic document, transmitting an error notification to said terminal device (Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories. The system "transmits an error notification" if no documents meet the search criteria in that it will indicated to the user that no results were found.).

Claim 92:

- Ferguson discloses the method of Claim 89, wherein
- said database includes electronic documents or tagged electronic documents together with their associated identifiers (Ferguson discloses this limitation in that the online services includes directories having "electronic documents."),
 - in said determining step, it is determined whether said database includes an electronic document or a tagged electronic document in accordance with an identifier received as said specification information (As indicated in the above rejection for Claim 18, Ferguson discloses this limitation.).

Claim 93:

Ferguson discloses the method of Claim 89, wherein in said determining step, it is determined whether said database includes an electronic document or a tagged electronic document in accordance with a keyword received as said specification information (As indicated in the above rejection for Claim 86, Ferguson discloses this limitation.).

Claim 94:

Ferguson discloses the method of Claim 89, further comprising the steps of:

- when an electronic document is received, in said receiving step, from said terminal device, requesting an authoring device to produce a tagged electronic document of said electronic document (As indicated in the above rejection for Claim 90, Ferguson discloses this limitation.); and
- when said tagged electronic document is received from said authoring unit, transmitting said tagged electronic document to said terminal device (As indicated in the above rejection for Claim 90, Ferguson discloses this limitation.).

Claim 95:

Ferguson discloses the method of Claim 89, further comprising the step of, when said tagged electronic document is transmitted to said terminal device, performing an accounting process associated with the fee to said terminal device (As indicated in the above rejection for Claim 25, Ferguson discloses this limitation.).

Claim 96:

Ferguson discloses the method of Claim 89, further comprising the step of, when said tagged electronic document is transmitted, performing an accounting process associated with the fee to said terminal device (As indicated in the above rejection for Claim 25, Ferguson discloses this limitation.) depending upon whether said authoring unit has performed an authoring process associated with said tagged electronic document (If no document is transmitted to the client device, then no fee is assessed.).

Claim 97:

- Ferguson discloses the method of Claim 89, wherein
- said database includes, together with said electronic documents, authoring permission/prohibition information indicating whether authoring of the respective electronic documents is permitted or prohibited (see Column 4, Lines 28-32 – Ferguson discloses this limitation in that the system charges the user a fee to access the online service. If the user has not subscribed to the service, then the user is denied access.), and
 - in said determining step, said authoring permission/prohibition information is used to determine whether an electronic document is included in said database (see Column 6, Line 65 through Column 7, Line 21 – Ferguson discloses this limitation in that the system controls access to the documents. The user may be granted access to some documents while being denied access to other documents.).

Claims 98 and 99:

Claims 98 and 99 merely recite computer software that performs the methods of Claims 84 and 89, respectively. Thus, Ferguson discloses every limitation of Claims 98 and 99, as indicated in the above rejections for Claims 84 and 89.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 23 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson.

Claim 23:

As indicated in the above rejection, Ferguson discloses every limitation of Claim 20. Ferguson also discloses said control means transmitting said list to said terminal device via said communication means (As indicated in the above rejection for Claim 20, Ferguson discloses this limitation.).

Ferguson fails to expressly disclose a control means that produces a list such that electronic documents retrieved by said retrieval means from said database are "partially included" in said list. However, the examiner takes Official Notice that prior art search engines, such as Google and Yahoo, produced lists of search results that

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displayed a small portion of each retrieved document on the list for the purpose of showing the user the context of the search term as it is used in the document. The examiner remembers using the *Yahoo* search engine while attending law school in November, 1997 and obtaining search results that included a list of the retrieved documents comprising a small portion of each retrieved document. The "small portion" of each document was included for the purpose of showing the user the context of the search term as it is used in the document.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Ferguson, to include a control means of said document providing device that produces said list such that electronic documents retrieved by said retrieval means from said database are "partially included" in said list for the purpose of showing the user the context of the search term as it is used in the document.

Claim 36:

As indicated in the above rejection, Ferguson discloses every limitation of Claim 33.

Ferguson fails to expressly disclose a control means that produces a list such that electronic documents retrieved by said retrieval means from said database are "partially included" in said list. However, the examiner takes Official Notice that prior art search engines, such as *Google* and *Yahoo*, produced lists of search results that displayed a small portion of each retrieved document on the list for the purpose of

showing the user the context of the search term as it is used in the document. The examiner remembers using the *Yahoo* search engine while attending law school in November, 1997 and obtaining search results that included a list of the retrieved documents comprising a small portion of each retrieved document. The "small portion" of each document was included for the purpose of showing the user the context of the search term as it is used in the document.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Ferguson, to include producing the list such that electronic documents retrieved from said database in said retrieving step are "partially included" in said list for the purpose of showing the user the context of the search term as it is used in the document.

Allowable Subject Matter

Claims 1-17 include allowable subject matter. However, the objections to the claims must be obviated before the claims are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Claims 1 and 13:

The prior art fails to disclose or suggest a document processing system that includes a terminal device, said terminal device comprising:

- categorizing means for categorizing an electronic document into one of a plurality of categories according to a characteristic of the electronic document, said categorizing means comprising all of the acts that are recited in the Specification of the present invention beginning on Page 61 at the heading “*4. Manual Categorization of Document Data*” and ending on Page 102 at the first partial paragraph, wherein said acts are performed during the categorization process.

Claims 2-12 and 14-17:

These claims are dependent upon Claims 1 and 13, and are thus allowable.

Response to Arguments

Applicant's arguments filed 22 February 2005 have been fully considered but they are not persuasive.

Applicant's Arguments for Claims 1-7, 9-22, 24-35, 37-40 and 84-99:

Applicant argues that Ferguson fails to disclose the limitations of these claims because Ferguson fails to disclose the “categorizing means for” and the “specification information input means for” recited in the claims. See *Applicant's Response* – Page 38, fourth full paragraph through Page 39, first full paragraph.

In regard to Claims 1-7 and 9-17, the examiner agrees, as indicated in the above discussion entitled “*Allowable Subject Matter*.”

In regard to the remaining claims, the examiner disagrees.

Claims 18-22, 24-35, 37-40 and 84-99 do not recite the “categorizing *means for*” and the “specification information input *means for*” that are recited in Claims 1 and 13. While Claims 26 and 39 recite “categorizing” and “specifying” features, they do not incorporate a “means for” clause in the limitations. Thus, these claims have a broader scope than Claims 1 and 13, and they read on Ferguson.

Accordingly, as indicated in the above rejections, Ferguson discloses every limitation of Claims 18-22, 24-35, 37-40 and 84-99.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
May 18, 2005

Heather Herndon
HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
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